

## **REMARKS/ARGUMENTS**

### ***Status of the Claims***

The Examiner rejected claims 39-41, 65-68, and 71-74 on various grounds, including 35 U.S.C. § 103 and 112.

Applicants have amended claim 39 to address the Examiner's section 112 rejections and, to further distinguish claim 39 from the cited prior art references, to add the following limitation: "a protuberance with a recessed surface for receiving a finger for clamping the forceps, the protuberance being located on an outside surface of one of the two opposed arms directly opposite the adjustable stop member." This limitation is fully supported by Figs. 16-19 and page 47 of the original specification (i.e., ¶ 182 of the published application), where it states: "There is a knob 108 with a recess 109 for the operator's finger on the external side of the arm. A strictly fixed location of the operator's finger relative to the arm is an essential condition for controlling the clamping force on the tissue. A recessed spot for the operator's finger makes manipulation easier, especially with a small size tool."

Applicants have amended claim 40 to address the Examiner's section 112 rejection by amended it into an independent method claim form. As amended, claim 40 recites a method comprising, among other things, the step of selecting an apparatus as claimed in claim 39 with electrodes that are dimensioned to have a volume which is at least 5 times that of the tissue portion volume. Although these types of claims are unusual, they are permitted under § 112 because they are definite. *See, e.g.*, U.S. Patent No. 5,179,579, independent claim 3.<sup>1</sup>

Applicants have amended apparatus claim 41 to depend from apparatus claim 39 instead of (now method) claim 40.

Applicants have amended claim 67 to recite that the stop member comprises a lug and one or more spacers positionable between the lug and the inside surface of the first opposed arm to accommodate the bonding of tissues of various thicknesses. Support is found in Fig. 17.

Applicants have resurrected previously withdrawn claims 69 and 70 and amended claim 69 to clearly state that the stop member *further* comprises an electromagnetic drive "that is operable to change the effective length of the stop member to enable an increase in tissue clamping force." The undersigned does not understand why claim 69 – a perfectly legitimate dependent claim – was ever withdrawn in the first place.

---

<sup>1</sup> Claim 3 recited: "A program storage device readable by a machine and tangibly embodying a representation of a program of instructions adaptable to be executed by said machine to perform the method of any one of claims 1 or 2."

Applicants have amended claim 71 to address the Examiner's section 112 rejections and, to further distinguish claim 71 from the cited prior art references, to add the following limitation: "a *lug* that is removably mounted to an inside surface of the first opposed arm...."

Applicants have cancelled claim 72.

Applicants have amended claim 73 to recite that the one or more spacers are positionable between the lug and the inside surface of the first opposed arm to accommodate the bonding of tissues of various thicknesses. Support is found in Fig. 17.

Applicants have amended claim 74 to recite that an adjustable knob “mounted on the outside surface of the first opposed arm opposite the lug.” Support is found in Figs. 17 and 19.

Applicants have presented a new claim 79 that depends from claim 74 and states that the adjustable knob has a recessed surface for receiving a finger for clamping the forceps, the protuberance being located on an outside surface of one of the two opposed arms directly opposite the adjustable stop member. This limitation is fully supported by Figs. 16-19 and page 47 of the original specification (i.e., ¶ 182 of the published application).

### Remarks

- **§ 112 ¶ 1 rejection of claims 68 and 74.**

The Examiner rejected claims 68 and 74 under § 35 U.S.C. § 112, ¶ 1 on the grounds that the specification “was silent as to the adjustable stop member being an adjustable knob.” Applicants respectfully traverse this rejection. Fig. 19 (annotated to the right) depicts an adjustable stop member that includes a lug 124 on the inside surface of a first arm 8, a knob 18 opposite the lug 124 on the outside surface of said first arm 8, and any number of spacers 106 positionable between the outside surface of the first arm and the knob 108. The knob 108 is adjusted in practice by removing or adding spacers between the knob 108 and arm 8. Page 49 of the specification expressly confirms that the knob is adjustable when it states that “[t]he initial and the final force is preset by selecting the length of the pin 120 and lug 124, as well as the number of spacers 106.”

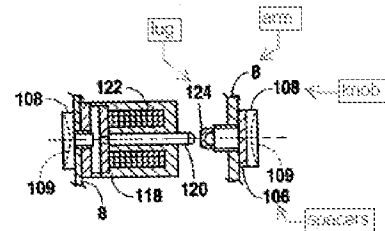


Fig. 19

In light of the fact that there was no prior-art based rejection of claims 68 and 74, Applicants respectfully submit that the claims are in condition for allowance.

- **§ 112 ¶ 2 rejections of claims 39-41, 65-68, and 71-74.**

Applicants respectfully submit that these rejections are moot in light of the amendments to and/or cancellations of the claims.

- **§ 103 rejections of claims 39-41, 65-67, and 71-73 over Auth in view of Goble et al.**

Applicants believe that the substantive amendments to independent claims 39 and 71 patentably distinguish the claims from the cited prior art references. With respect to claim 39, neither Auth nor Goble disclose “a protuberance with a recessed surface for receiving a finger for clamping the forceps ... directly opposite an adjustable stop member.” With respect to claim 71, neither Auth nor Goble disclose “a lug that is removably mounted to an inside surface of the first opposed arm....”

### ***Conclusion***

In view of the foregoing amendments and arguments, Applicants respectfully ask that the rejections be withdrawn. Believing that all things raised in the Examiner's February 12, 2008, Office Action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully submitted,



Eric W. Cernyar  
Reg. No. 45,919  
Hanor, Lively, Cernyar & Saba  
750 Rittiman Road  
San Antonio, TX 78209  
Phone: (719) 689-0700  
Cell: (719) 216-6793  
Fax: (719) 325-8318